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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,962	01/07/2002	Mika Peralá	3501-1001	6257

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YOUNG & THOMPSON  
745 SOUTH 23RD STREET  
2ND FLOOR  
ARLINGTON, VA 22202

EXAMINER

ROBERTSON, JEFFREY

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/019,962

Applicant(s)

PERALA ET AL.

Examiner

Jeffrey B. Robertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 is/are allowed.
- 6) ☒ Claim(s) 1-7,9,10 and 12 is/are rejected.
- 7) ☐ Claim(s) 13 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 9, 10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Gasmena (U.S. Patent No. 5,703,178).

For claim 1, in column 2, lines 43-50, Gasmena teaches coatings that contain an epoxy resin, an epoxy silane, a siloxane, and optionally a pigment. In column 6, lines 22-26, Gasmena teaches that the epoxy resin may be an aliphatic epoxy resin. In column 2, lines 34-36, Gasmena teaches that the epoxy resin makes up 1-20% by weight of the composition. For claims 1, 9, and 10, in column 3, lines 38-65, Gasmena teaches the addition of an epoxy functional silane and specifically mentions glycidyoxypropyltrimethoxysilane as preferred example. In column 4, lines 1-5, Gasmena teaches that the epoxy silane is present in an amount of 0.5 to 5 % of the composition. In column 4, lines 16-40, Gasmena teaches the addition of a polysiloxane that has a molecular weight of 500 to 3500, which significantly overlaps with applicant's molecular weight. Applicant's R<sub>1</sub> and R<sub>2</sub> significantly overlap with Gasmena's R<sub>3</sub> and R<sub>4</sub>. In column 4, lines 50-52, Gasmena teaches that the amount of polysiloxane in the coating is from 0.5 to 5 %.

For claim 2, the amounts of the components set forth by Gasmena result in ratios that fall within applicant's claimed range.

For claim 12, in column 9, lines 50-62, Gasmena teaches a two-part kit where the composition is placed in a first container, and an amine hardener is placed along with other additives in a second container.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gasmena (U.S. Patent No. 5,703,178) as applied to claim 1 above, and further in view of Eklund et al. (U.S. Patent no. 6,180,726).

For claims 3-5, Gasmena teaches the limitations of claim 1 as detailed above. Although Gasmena teaches aliphatic glycidal epoxy resins, Gasmena does not teach the polyglycidyl ether of pentaerythritol as set forth in claim 5, which would also satisfy the limitations of claims 3 and 4.

In column 2, lines 45-64, Eklund teaches coatings containing epoxy resins. In column 8, lines 55-63, Eklund teaches that pigments may be added to the coating compositions thus forming a paint. In column 6, lines 44-46, Eklund teaches the use of aliphatic epoxy resins such as pentaerythritol polyglycidyl ether.

Eklund and Gasmena are analogous art in that they both teach the use of epoxy resins in paint compositions that also contain silicone components. It would have been obvious to one of ordinary skill in the art at the time of the invention to use pentaerythritol polyglycidyl ether as the aliphatic glycidal epoxy resin. The motivation would have been that Gasmena provides the express suggestion to use this type of an epoxy resin. One of ordinary skill in the art would have looked to Eklund to provide specific examples of such resins.

5. Claims 3, 4, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gasmena (U.S. Patent No. 5,703,178) as applied to claim 1 above, and further in view of Iwamura et al. (U.S. Patent no. 5,705,567).

For claims 4 and 5, Gasmena teaches the limitations of claims 1 and 3 as detailed above. Although Gasmena teaches aliphatic glycidal epoxy resins, Gasmena does not teach the triglycidyl ether of glycerine or neopentyl glycol diglycidyl ether as set forth in claims 6 and 7, which would also satisfy the limitations of claims 3 and 4.

In column 1, lines 10-31, Iwamura teaches paints containing epoxy resins. In column 10, lines 26-38, Iwamura teaches the use of aliphatic epoxy resins such as triglycidyl ether of glycerine or neopentyl glycol diglycidyl ether.

Iwamura and Gasmena are analogous art in that they both teach the use of epoxy resins in paint compositions that also contain silicone components. It would have been obvious to one of ordinary skill in the art at the time of the invention to use triglycidyl ether of glycerine or neopentyl glycol diglycidyl ether as the aliphatic glycidal epoxy resins. The motivation would have been that Gasmena provides the express

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suggestion to use these types of epoxy resins. One of ordinary skill in the art would have looked to Iwamura to provide specific examples of such resins.

***Allowable Subject Matter***

6. Claim 8 is allowed.
7. Claims 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

8. Applicant's arguments have been fully considered but they are not persuasive.

Upon further review of the Declaration submitted 3/12/2004, and consultation with the examiner's supervisor, the Declaration is not commensurate in scope with the claimed subject matter. Table I of the Declaration sets forth weight percentages of the Gasmene reference with and without silicone polyether as well as weight percentages used for the present composition. However, since claim 1 does not contain any limitations as to weight percentages, the declaration does not distinguish the full scope of claim 1.

Also, at the weight percentages selected by applicant, there appears to be a difference between the Gasmene compositions and the instant compositions in terms of weathering properties such that the presence of the silicone polyether would "materially affect the basic and novel characteristics" of the claimed composition. However, the amounts of the components are very different, particularly between the amounts of the

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Siloxane added in Gasmena and the "Present invention" such that it is difficult to compare the properties resulting from these compositions.

In addition, regarding the weight percentages of the declaration as they relate to claim 2, the weight ratio claimed in claim 2 is 1:2-5:2-5. The weight percentages set forth in Table 1 for the "Present invention" appear to be outside this ratio as between the Epoxy functional silane and the Epoxy. At a weight percentage of epoxy functional silane of 4.4, it appears that the maximum amount of epoxy allowed would be 22% by weight. Table 1 of the Declaration states that the amount of Epoxy is 23% by weight and this appears to be outside this ratio. In view of the above comments, the Declaration is not persuasive and the previous rejections have been reinstated.

Last, the examiner apologizes for not raising these issues earlier and apologizes for any inconvenience.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jeffrey B. Robertson  
Primary Examiner  
Art Unit 1712

JBR